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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,845	05/31/2001	Henri Waelbroeck	10209-008	9460
20583	7590	11/16/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/870,845

Applicant(s)

WAE LBROECK ET AL.

Examiner

JAGDISH PATEL

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3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 57-61 and 72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-61 and 72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/17/05, 10/9/01</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. In response to applicant's response dated 8/28/06, to the election/restriction requirement, Claims 1-56 and 62-71 are canceled. The applicant have elected species of claims 57-61 and requested cancellation of claims 1-56 and 62-71 as non-elected species.

Accordingly, claims 57-61 and new claim 72 (depending upon claims 57) remain pending and have been examined.

2. The disclosure is objected to because of the following informalities:

The title of the application reads "Method for directing and executing certified trading interest", whereas the claimed invention pertains to order management in particular matching and executing orders.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 57-61 and 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed invention is indefinite for the following reasons:

(i) The claim recites that the participant information stored, however, the executing steps occur without comparison of the second order having associated a price and a size with corresponding price and size of the first order stored in step (b).

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(ii) There is no positive antecedent basis for limitation “the price and size” because neither the first nor the second order has been recited as having respective price and size when the order are received or that the participant information contain this information.

(iii) The first order has a plurality of conditions associated with it (specified as (i) through (iii) in step (a)). It appears that the order is to be executed under one of these plurality of conditions. However, steps (d) and (e) indicate that the first order is executed independent of other step.

(iv) The claim fails to define the term “random match check events” in conjunction with the first order or order matching process. Step (e) recites “randomly-timed match check events”. Are these two terms related or different?

(v) The claim recites “wherein other orders will match against the first order if the price and size match and if said first participant information indicates that said first order is to be exposed to randomly-timed match check events” only *as expected or intended result* of executing randomly-timed match check events. It is unclear what result occurs as a result of this execution step.

(vi) The limitation “other orders” lacks proper antecedent basis. It is unclear which orders are other orders because the claim only recites

(vii) The claim recites conditional limitations (d) and (e) which renders it indefinite because the claim fails to recite what happens when or if the conditions stated in the limitations do not occur. See explanation below.

Let us define the following conditions recited in the claimed invention.

Condition C<sub>1</sub> = price and size of the first and the second order match

C<sub>2</sub> = first order is exposed immediate matching against incoming orders

C<sub>3</sub> = first order is to be exposed to randomly-timed match check events

C<sub>4</sub> = price and size of the other orders match

Step (d) recites

If C<sub>1</sub> and C<sub>2</sub> = execute the second order against the first order;

Otherwise = ????

In other words the claim is silent about what happens if one of the C<sub>1</sub> and C<sub>2</sub> is not satisfied. Is step (e) is performed in alternative to step (d) as discussed.

(viii) Step (e) recites execution of “randomly-timed match check events”. This step is unclear because the claim fails to establish any relationship of the randomly timed match check events to the first order, second order or other orders. Furthermore, it is not clear if the two

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executing step occur in any in conjunction with other or independent of each other since both apply to the execution of the first order.

***Conclusion***

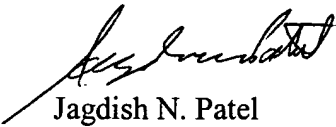
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

11/6/06